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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Fabry et al. Confirmation No.: 1938  
Appl. No. : 10/009,453  
Filed : November 5, 2001  
Grp./A.U. : 1617  
Examiner : Lauren Q. Wells  
  
Docket No. : H 4132 PCT/US  
Customer No.: 23657

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Date

Marlene Capreri  
Signature of certifier

Marlene Capreri  
Typed or printed name of certifier

APPEAL BRIEF TRANSMITTAL

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
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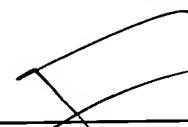
Sir:

Appellants' brief, in triplicate, is transmitted herewith in accordance with 37 CFR 1.192.

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Respectfully submitted,

  
Steven J. Trzaska  
(Reg. No. 36,296)  
Attorney for Applicant(s)  
(215) 628-1416

Cognis Corporation  
300 Brookside Avenue  
Ambler, PA 19002



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**BRIEF ON APPEAL UNDER 37 C.F.R. 1.192**

Sir:

**REAL PARTY IN INTEREST**

The real party in interest is Cognis Deutschland GmbH & Co. KG,  
Henkelstrasse 67, 40589 Duesseldorf, Germany.

**RELATED APPEALS AND INTERFERENCES**

None.

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Appl. No. : 10/009,453  
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### STATUS OF CLAIMS

Claims 9, 10, 12-16 and 18-24 are the subject of this appeal.

### STATUS OF AMENDMENTS

No amendments were made after final rejection.

### SUMMARY OF THE INVENTION

Briefly stated, the present invention is directed to a cosmetic and/or pharmaceutical composition containing an active ingredient and a metal soap in the form of nanoparticles having a mean diameter of from about 10 to 300 nm, wherein the nanoparticles are coated with a protective colloid, an emulsifier or both, and wherein the composition exhibits enhanced consistency and more intense white opacity. See page 1, lines 5-24.

### ISSUES

Whether claims 9, 10, 12-16 and 18-24 are obvious under 35 U.S.C. § 103(a) over Ansmann et al. (WO 99/11235) in view of Miles (US 2,456,437).

### GROUPING OF THE CLAIMS

The claims stand and fall together.

### ARGUMENT

**Neither of the references relied upon by the Examiner, either alone or in combination, contain the requisite teaching or suggestion to render the claimed invention *prima facie* obvious.**

The Ansmann reference admittedly fails to contain any teaching or suggestion relating to the use of metal soap nanoparticles which are coated with a protective colloid, an emulsifier, or both. In an effort to overcome this admitted lack of teaching or suggestion, the Examiner relies upon the teachings of the Miles reference. Appellant

respectfully submits, however, that the Examiner has failed to show the existence of any motivation on the part of one having ordinary skill in the art to want to combine the teachings of these two references. It is very well settled that an Examiner cannot establish obviousness through references describing various aspects of an Applicant's invention unless the Examiner also provides evidence of motivating force which would compel a person skilled in the art to do what Applicant has done. See, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Since the Examiner has not provided any requisite evidence of motivating force, Appellant respectfully submits that said two references should not be combined.

Appellant has argued on numerous occasions that the problem associated with Miles' teaching is that it is silent with respect to the potential for using organic materials to coat **inorganic** soap particles such as the claimed **metal** soap particles. The only soap particles disclosed by the Miles reference as being coated with organic coating material are **sodium** soaps of fatty acids. Thus, even if a person of ordinary skill in the art had both the Ansmann and Miles references in front of them, they would not be motivated to use the organic material of the Miles reference to coat the metal soaps of the Ansmann reference, since there is no teaching or suggestion in either reference to do so. Moreover, there is no teaching or suggestion in either reference that the problem addressed by the Miles reference, i.e., elimination of dust particles, is also a problem experienced by metal soaps. Thus, Appellant respectfully submits that the use of the organic materials of the Miles reference in order to coat the metal soaps of the Ansmann reference is far from obvious.

The Examiner contends, however, that because the Miles reference fails to **exclude** coating inorganic soap particles, but instead refers to soap particles in general, it would thus be *prima facie* obvious to the routineer to want to coat inorganic soap particles as well as organic soap particles. In response thereto, Appellant again respectfully submits that *prima facie* obviousness needs to be based upon some teaching or suggestion found **within** a relied upon reference. *Prima facie* obviousness **CANNOT** be based on what a reference **does not teach or suggest**. It is extremely well settled that that which is within the capabilities of one skilled in the art is not synonymous with obviousness. See, *Ex parte*

*Gerlach*, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). Moreover, with respect to the Examiner's contention in the Office Action dated March 24, 2004, page 5, first paragraph, that "...the metal soaps of Ansmann are nanoparticles and that all particles of such a small size range are subject to forming dust particles.", Appellant respectfully submits the Examiner has failed to provide any evidence in support of this contention. The Examiner appears to be arguing that metal soap nanoparticles **inherently** have dust particle issues due to their size. In response thereto, Appellant would like to note that it has been held that an Examiner, if relying upon a theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support a determination that an allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See, *In re Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990). Moreover, it has also been held that, "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient." See, *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981). Appellant respectfully submits that because the Examiner has failed to offer any evidence in support of the contention that **all** nanoparticles inherently suffer dust particle problems, this contention amounts to nothing more than mere speculation and assumption on the Examiner's part. Unfortunately, it has been held that, "The Patent Office ... may not, because it may **doubt** that the invention is patentable, resort to speculation, unfounded assumptions or hindsight to supply deficiencies in its factual basis." See, *In re Warner*, 154 USPQ 173, 178 (CCPA 1967).

Finally, Appellant would also like to note that it is well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. See, *In re Soli*, 137 USPQ 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is known and therefore obvious. Subjective opinions are of little weight in determining obviousness. See, *In re Wagner et al*, 152 USPQ 552 (CCPA 1967).

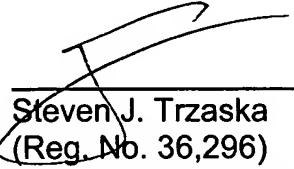
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SUMMARY

Neither of the references relied upon by the Examiner, alone or in combination, contain the requisite teaching or suggestion to render the claimed invention *prima facie* obvious.

It is requested for the reasons given above, that the Board find for Appellant on all of the issues, and reverse the Examiner's Final Rejections.

Respectfully submitted,

  
\_\_\_\_\_  
Steven J. Trzaska  
(Reg. No. 36,296)  
Attorney for Applicant(s)  
(215) 628-1416

Cognis Corporation  
300 Brookside Avenue  
Ambler, PA 19002

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Enc.: Appendix

APPENDIX

CLAIMS ON APPEAL

Claim 9: A composition comprising:

- (a) an active ingredient selected from the group consisting of a cosmetically-active ingredient, a pharmaceutically-active ingredient, and mixtures thereof; and
- (b) metal soap nanoparticles having a mean diameter of from about 10 to 300 nm, wherein the metal soap nanoparticles are coated with a coating compound selected from the group consisting of a protective colloid, an emulsifier, and mixtures thereof.

Claim 10: The composition of claim 9 wherein the metal soap nanoparticles have a mean diameter of from about 50 to 150 nm.

Claim 12: The composition of claim 9 wherein the metal soap nanoparticles are present in the composition in an amount of from about 0.1 to 5% by weight, based on the weight of the composition.

Claim 13: The composition of claim 9 wherein the metal soap nanoparticles are present in the composition in an amount of from about 0.5 to 3% by weight, based on the weight of the composition.

Claim 14: The composition of claim 9 wherein the metal soap nanoparticles are present in the composition in an amount of from about 1 to 2% by weight, based on the weight of the composition.

Claim 15: A process for enhancing the stability, opacity and consistency of a cosmetic or pharmaceutical composition comprising adding metal soap nanoparticles having a mean diameter of from about 10 to 300 nm to the composition, wherein the metal soap

nanoparticles are coated with a coating compound selected from the group consisting of a protective colloid, an emulsifier, and mixtures thereof.

Claim 16: The process of claim 15 wherein the metal soap nanoparticles have a fmean diameter of from about 50 to 150 nm.

Claim 18: The process of claim 15 wherein the metal soap nanoparticles are added to the composition in an amount of from about 0.1 to 5% by weight, based on the weight of the composition.

Claim 19: The process of claim 15 wherein the metal soap nanoparticles are added to the composition in an amount of from about 0.5 to 3% by weight, based on the weight of the composition.

Claim 20: The process of claim 15 wherein the metal soap nanoparticles are added to the composition in an amount of from about 1 to 2% by weight, based on the weight of the composition.

Claim 21: The composition of claim 9 wherein the coating compound is present on the nanoparticles in an amount of from about 0.1 to 20% by weight, based on the weight of the nanoparticles.

Claim 22: The composition of claim 9 wherein the coating compound is present on the nanoparticles in an amount of from about 5 to 15% by weight, based on the weight of the nanoparticles.

Claim 23: The process of claim 15 wherein the coating compound is present on the nanoparticles in an amount of from about 0.1 to 20% by weight, based on the weight of the nanoparticles.

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**Claim 24:** The process of claim 15 wherein the coating compound is present on the nanoparticles in an amount of from about 5 to 15% by weight, based on the weight of the nanoparticles.